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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,615	11/15/2000	Yuji Ayatsuka	112857-264	3858
29175	7590	01/05/2006		
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			EXAMINER POLLACK, MELVIN H	
			ART UNIT	PAPER NUMBER
			2145	
DATE MAILED: 01/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/713,615	Applicant(s) AYATSUKA ET AL.	
	Examiner Melvin H. Pollack	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8,9,11,12,14,18-23,25-30 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,9,11,12,14,18-23,25-30 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. P-11-327670.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 3, 8, 9, 11, 12, 14, 18-23, 25-30, and 33-39 have been considered but are moot in view of the new ground(s) of rejection.
2. The applicant accepts the replacement drawing and related amendments to the specification. The objection to the drawing is withdrawn.
3. The examiner accepts the amendment to claims 18 and 33. The 112 rejection is withdrawn.
4. In regards to the art rejections, applicant has changed the scope of the claims by making the identifying process automatic. The examiner has determined that the change of scope is sufficient to require further search and consideration. The original rejections have been withdrawn in favor of new rejections.
5. The applicant has added the limitation for automatically identifying the targets on the basis of the identification information imaged, wherein the identification information is a barcode (Fig. 6, #50) or other visual marker (P. 36). In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.). That said, the examiner will add new art to show the automated process.

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6. Therefore, this rejection is final.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim s 1, 3, 8, 9, 11, 12, 14, 18, 19 - 21, 23, 25-30, 33, 34, and 36 - 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al. (6,463,343) in view of Slocum et al. (6,430,306).

9. For claim 1, Emens teaches a portable information processing terminal (abstract) adapted to be connected to one or more than one targets (col. 1, line 1 – col. 2, line 20) by way of a network (Fig. 1), said terminal comprising:

- a. An imaging means (Fig. 1, #116) for imaging visible identification information possessed by the targets (col. 5, lines 55-65);
- b. An identification means (col. 5, lines 1-15) for identifying the targets on the basis of the identification information imaged by said imaging means (col. 5, line 65 – col. 6, line 15);
- c. A connection means (Fig. 3, #302) for establishing connection between itself (Fig. 1, #104) and the targets identified by said identification means (Fig. 1, #120);
- d. An image confirmation means for confirming the images of the targets including said identification information (col. 5, lines 15-45); and

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- e. Said confirmation means displays status of connection to the one or more than one targets (col. 6, lines 15-45).
10. For claims 3 and 23, Emens teaches (abstract) an information input/output method and system (col. 1, line 1 – col. 2, line 20) comprising:
- a. A user terminal to be used by a user (Fig. 1, #102);
 - b. One or more than one targets (Fig. 1, #120) connected to said user terminal (Fig. 1, #104) in a format adapted to transfer of information and including visible identification information (col. 3, lines 30-50; col. 3, line 65 – col. 4, line 10);
 - c. An identification means for an identifying the targets on the basis of the identification information imaged by said imaging means (col. 4, lines 15-60); and
 - d. A connection means for establishing connection between the user terminal and the targets identified by said identification means (col. 2, line 40 – col. 3, line 15);
 - e. Said user terminal includes a display screen (Fig. 1, #108); and
 - f. The images and status of connection to the one or more than one targets taken by said imaging means is displayed on said display screen (Fig. 2D and 2E).
11. For claims 1, 3, and 23, Emens does not expressly disclose identification means for automatically identifying the targets on the basis of the identification information imaged by said imaging means, nor the step of automatically identifying the targets. Slocum discloses a method and system (abstract) of image capturing (col. 1, line 1 – col. 4, line 65) wherein a camera system (Fig. 1) wherein important objects are identified (Fig. 2, #120) and then compared to images within a database (Fig. 2, #170) to determine the identity attached to the image (Fig. 2, #180) and/or to group the image into a subgroup representative of the group's type (col. 7, lines 40-55;

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col. 8, lines 45-60). The examples of identified objects include documents (col. 16, lines 5-25) or people (col. 9, lines 35-50), but other information may be collected (col. 19, line 60 – col. 20, line 5). Slocum does not expressly disclose the storage and processing of information related to the specific objects for imaging as recited in the claimed invention. However, the specific meaning/interpretation of the queries loaded onto the server does not patentably distinguish the claimed system. Further, the recited statement of intended use does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made that an Emens system would spark interest in a variety of image handling network systems including those with different intended usage. Further, these differences are only found in the non-functional data stored on the article of manufacture. Such data is not functionally related to the substrate of the article of manufacture.

12. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

13. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any image data in the fields of the article of manufacture as shown in Emens and Slocum because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

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14. At the time the invention was made, one of ordinary skill in the art would have added Slocum to Emens in order to determine ways to improve Emens' organization and usage of image information (col. 1, lines 15-20 and 35-60).

15. For claims 8 and 25, Emens teaches that said user terminal is connected to said targets by way of a network (col. 3, lines 25-30), said targets have respective network addresses (col. 3, lines 33-38), said information input/output system further comprising a data base means for controlling the correspondence between the identification information of each target and its network address (col. 5, lines 20-22), and said connection means being adapted to connect the user terminal and the targets by referring to said data base means for the network address of each target corresponding to the identification information (col. 6, lines 35-45).

16. For claims 9, 26, Emens teaches that said connection means sustains the connection between the targets and said user terminal as long as the imaging means is imaging the targets or their identification information (col. 5, lines 20-25).

17. For claims 11, 27, Emens teaches that said connection means sustains the connection between the targets and said user terminal as long as the targets identified by said identification means are displayed on said display screen (Fig. 2G in view of Fig. 2H).

18. For claims 12, 28, Emens teaches that said images of the targets taken by said imaging means is held on said display screen as long as said connection means sustains the connection between the targets and said user terminal (col. 5, lines 20-25).

19. For claims 14, 29, 30, Emens teaches that said user terminal has a storage means for storing the taken images of said targets identified by said identification means, and said

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connection means establishes connection between said user terminal and relevant taken targets in response to the display of said image on said display screen (col. 5, lines 20-22).

20. For claims 18, 33, Emens teaches that said user terminal has a user input means (col. 6, line 5; cursor control device), and said application means transfers the user input data input by using said user input means as user input data on a computer system, or a target, as long as said connection means sustains the connection between the computer system and the user terminal (Fig. 3, #314 and #318).

21. For claims 19, 34, Emens teaches that said application means obtains the data to be shown from targets and displays them on the display screen as long as said connection means sustains the connection between said targets (Fig. 2H) including said data to be shown and updated regularly or irregularly and the user terminal (col. 6, lines 40-60).

22. For claims 21, 36, 38, 39, Emens teaches that said application means transmits the video recording appointment information input at said user terminal to a target, or a video recording/reproduction apparatus having a video recording appointment feature so long as said connection means sustains the connection between said video recording/reproduction apparatus and the user terminal (col. 5, lines 15-20).

23. For claims 22, 37, Emens teaches that said application means displays an image of operation for controlling remotely controllable targets on the display screen and transmit the user operation displayed on the display screen to the targets as long as said connection means sustain the connection between the target and the user terminal (col. 6, lines 40-60).

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24. Claims 20 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens and Slocum as applied to claims 3 and 23 above, and further in view of Fowler et al. (6,714,977).

25. For claims 20, 35, Emens does not expressly disclose that said application means receives alarms from a target, or a device having an alarm feature, and execute said alarm on said user terminal as long as said connection means sustains the connection between the target and the user terminal. Fowler teaches a method (abstract) of providing remote control of network devices (col. 1, line 1 – col. 4, line 51) using imaging systems (col. 7, line 25 – col. 8, line 10) to connect and monitor devices (col. 8, lines 10-60), in which alarms execute on a user terminal (Fig. 17; col. 8, line 60 – col. 9, line 5). At the time the invention was made, one of ordinary skill in the art would have added Fowler alarms to Emens in order to handle device problems (col. 3, lines 5-15) and to provide room information to the user (col. 3, lines 20-40).

26. Claims 1, 3, and 23 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Emens as applied to claims 1, 3, and 23 above, and further in view of Bansal (2002/0000468).

27. Emens, as shown above, does not expressly disclose an identification means for automatically identifying the targets on the basis of the identification information imaged by said imaging means. As the claims do not expressly disclose capturing of an image and/or visible identification information, other forms of imaging means, such as barcode readers, may be used. Bansal teaches a method and system (abstract) of acquiring and storing identification information such as URLs (Paragraphs 1-6) by imaging barcodes (Paras. 20-23), and the information in a barcode is automatically translated into identification information (Para. 21). At the time the

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invention was made, one of ordinary skill in the art would have used Bansal's barcode reader in Emens in order to simplify the process of adding information (Paras. 29 and 30).

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They relate further teachings on home networks and/or visual indicia.

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP

22 December 2005


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER